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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/798,311

Applicant(s)

BLUM ET AL.

Examiner

PAUL FISHER

Art Unit

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/10/2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7,9-20,28,29,31-34 and 36-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7,9-20,28,29,31-34 and 36-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Drafts/Person's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Amendment submitted on June 10, 2010 has been acknowledged. Claims 3, 8, 21-27, 30 and 35 have been canceled. Claims 1, 2, 4-7, 9-20, 28-29, 31-34, and 36-42 are currently pending and have been considered below.

Claim Objections

2. Claim 28 is objected to because of the following informalities: in line 18 of claim 28, the recited phrase "sending the electronic folder at a remanucturer" appears to include a typo and a miss spelling particular that remanucturer is a miss spelling of --remanufacture-- and the phrase should read --sending the electronic folder to a remanufacture--. Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-2, 4-7, 9-20, and 38-41 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to an examiner is that a § 101 process must (1) be tied to a particular machine or apparatus or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

To qualify as a § 101 statutory process, the claim should recite the particular machine or apparatus to which it is tied, for example by identifying the machine or apparatus that accomplishes the method steps, or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test.

Here, applicant's method steps fail the first prong of the new test because while the claims recite a central server outputting information or sending information the steps of sending or outputting are considered insignificant steps or insignificant extra-solution activity which will not transform an unpatentable principle into a patentable process. That is to say the significant step of determining a disposition of said vehicular part is not being performed by a machine particular or otherwise and therefore the method steps fail to be significantly tied to any particular machine. Further the limitation of "automatically transmitting" while done automatically is not being performed by a machine particular or otherwise. That is to say a person can automatically perform this

task. Further the step of transmitting itself if it were being performed by a particular machine is considered to be an insignificant extra solution activity step and thus does not constitute a significant tie to a particular machine thus would not put the claim in a status to overcome the 101 rejection.

Further, applicant's method steps fail the second prong of the test because there is no underlying subject matter has been transformed. A document is not transformed into another state or thing by merely updating the information stored in the document. That is to say the document is, still a document the addition of new data is not a transformation.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 28, 29, 31, 32, and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Joao (US2002/0016655A1).**

As per claim 28, Joao discloses a data center used in a remote evaluation of a vehicular part (Figure 1; discloses a central processing computer or server which takes in data from various other locations for the evaluation of vehicle parts), said data center comprising:

a computer server adapted to communicate with a vehicular dealer and an assessment center (Figure 1; discloses that the central processing computer or server communicates with other computers across the network, this would include the vehicle dealer computer character 40 and the vehicle service provider computer or the assessment center. Further the central processing computer could also communicate with any of the computers connected to the network), said computer server comprising:

input means for receiving, from said vehicular dealer, said electronic folder including said description information regarding said condition of said vehicular part in an electronic folder (Page 21, paragraph 283; discloses that the user enters information that is to be sent to the central server via a computer. Page 12, paragraph 173; discloses various input devices to enter information into the system);

output means for sending said description information to said assessment center (Page 15, paragraph 213; discloses output devices the could be used by the system);
and

said input means for receiving, from a terminal of said assessment center, a grade for the vehicular part, said electronic folder having been modified at said terminal of said assessment center to include said (Page 22, paragraph 293; discloses the user being sent the report or assessment. Page 12, paragraph 173; discloses various input devices to enter information into the system. Page 20, paragraph 275; discloses that the user of the system can be any of the parties which include vehicle service providers any of these parties can enter information or modify the electronic folder. Page 21, paragraph 285; discloses that a user of the system can modify the document to include

an assessment or information regarding the vehicles malfunction problems. Page 22, paragraph 299; discloses that at any time during the process any user can add additional information this includes vehicle service providers and this is done through their respective computer, from this it is clearly shown that the assessment center enters data regarding the vehicle and its parts at any time during the process and this entry is done from a terminal at the assessment center and that the system includes an input means for receiving this information).

said output means for sending said electronic folder, once modified to include said grade, to the vehicular dealer, where the grade will be used to determine the disposition of the vehicular part and, also sending the electronic folder at a remanufacturer where the grade will be used for sorting the vehicular part (Page 15, paragraph 213; discloses output devices that could be used by the system, who gets sent the data is considered intended use of the system claim, further what gets sent is considered to be merely a title given to the data. What the data is then used for is again intended use, these limitations fail to impart new structural limitations on the claim and therefore do not serve to distinguish the claimed invention from the prior art).

The information being transfer or sent and received is considered to be non-functional descriptive material since it adds not further limitations to the structure of the system and is therefore given little or no patentable weight.

As per claim 29, Joao discloses the above-enclosed invention; Joao further discloses wherein said description information comprises at least one of textual data, binary data, scanned documents, digital images, digital audio and video of said

vehicular parts (Page 21, paragraph 286, Page 12, paragraph 177, Page13, paragraph 185).

As per claim 31, Joao discloses the above-enclosed invention, Joao further discloses comprising a server database for storing at least a portion of said description information in said electronic folder (Page 15, paragraph 206; discloses that the system includes a database that will be used to store all of the information).

As per claim 32, Joao discloses the above-enclosed invention, Joao further discloses wherein said computer server is further adapted to communicate with a third location and said output means further sends said assessment to said third location (Page 22, paragraph 299; discloses that various parties can access the system, and these parties include intermediaries, these parties can obtain information and input information).

As per claim 36, Joao discloses the above-enclosed invention, Joao further comprising a server database for storing at least a portion of said description information in said electronic folder (Page 15, paragraph 206; discloses that the system includes a database that will be used to store all of the information).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 1, 2, 4-7, 9-20, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao (US2002/0016655A1), in view of Amir M. Hormozi: "Parts Remanufacturing in the Automotive Industry" (First Quarter 1997) hereafter Hormozi, further in view of Bell (5,497,235) hereafter Bell.**

As per claim 1, Joao discloses a method for remotely evaluating a vehicular part (Page 1, paragraph 9; discloses that the invention pertains to vehicle maintenance, and that information is shared. Page 2, paragraph 15; discloses that there is a central point in which the different parties communicate through and that one of the parties are vehicle parts providers) comprising:

obtaining, from a vehicular dealer, description information regarding said vehicular part in an electronic folder (Page 21, paragraph 281; discloses that the information is gathered about state of disrepair, further it states that this information can be obtained from a vehicular dealer);

sending, from a central server, said electronic folder including said description information to an assessment center (Page 22, paragraph 293; discloses that the central processing computer or central server transmits or sends the diagnostic report and/or repair, maintenance, and/or servicing report to the user's computer, Page 21, paragraph 282; discloses that a user can consist in any number of people including vehicle service providers and vehicle insurance providers which are equivalent to an assessment center, from this it is shown that a central server sends an electronic folder including description information to an assessment center);

modifying, at a terminal at said assessment center, the electronic folder to include a grade for the vehicular part, the electronic folder once modified corresponding to an updated electronic folder (as best understood by the Examiner a grade is equivalent to an assessment of a part based on the applicant's specification page 9, paragraph [0034] which states "...the folder is then returned to the dealer along with the assessment or grading...") (Page 20, paragraph 275; discloses that the user of the system can be any of the parties which include vehicle service providers any of these parties can enter information or modify the electronic folder. Page 21, paragraph 285; discloses that a user of the system can modify the document to include an assessment or information regarding the vehicles malfunction problems. Page 22, paragraph 299; discloses that at any time during the process any user can add additional information this includes vehicle service providers and this is done through their respective computer, from this it is clearly shown that the assessment center enters data regarding the vehicle and its parts at any time during the process and this entry is done from a terminal at the assessment center);

receiving from said assessment center, the updated electronic folder (Page 22, paragraph 297; discloses that the service provider or repair facility which is considered the assessment center can transmit back to the central server updated or modified information including the assessment of the vehicle and or part. Since the grade is equivalent to the assessment then the Examiner asserts that a grade is shown as well);

sending said updated electronic folder from said central server to said vehicle dealer (Page 3, paragraph 39; discloses that the apparatus can send or output repair

reports to the vehicle dealer; Page 10, paragraph 157; discloses that the vehicle dealer computer is in communication with the central processing computer or central server);

displaying said grade, at said vehicular dealer (Page 15, paragraph 213; discloses output devices the could be used by the system, which includes a display for displaying the information. Page 15, paragraph 214; discloses that the information stored in the system can be made available to any of the users of the system which include the vehicular dealer, from this it is obvious that the information is displayed);

automatically transmitting to an Original Equipment Manufacturer (OEM) a notification of the disposition (Page 5, paragraph [0060]; discloses that notifications can be sent to the Manufacturer automatically);

Joao fails to fully disclose determining a disposition of said vehicular part based on said grade of said assessment and at a remanufacturer, sorting the vehicular part according to the grade.

Hormozi, which talks about parts remanufacturing in the automotive industry, teaches determining whether said vehicular part how a part maybe disposed based on said assessment or grade (Page 26, paragraphs 1 and 2; teach that there are different strategies in saving customers money and address the concerns of different constituencies, some of them include recycling and remanufacturing, as discussed above since the grade is equivalent to the assessment then the Examiner asserts that a grade is shown as well, and therefore the disposition is based on grade. Page 1, paragraph 4; teaches that the process of remanufactured products includes inspection to determine if the product is capable of being remanufactured parts are too badly worn

are replaced. This inspection is an assessment of the part itself to determine if it needs to be replaced or is capable of being salvaged).

From this teaching of Hormozi, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the part servicing system provided by Joao, with the use of recycling or remanufacturing as taught by Hormozi, to accomplish the required services for the customer for less. As mentioned in Hormozi many dealers or manufacturers don't have the resources to take on such a task as repairing parts or recycling them and often these parts were just replaced with brand new ones. Hormozi shows that the process of disposing of parts that could be salvaged is wasteful and also costs more money and energy then having those parts repaired or recycled.

The combination of Joao and Hormozi, fail to explicitly disclose sorting the vehicular part according to the grade.

Bell, which talks about inspecting and grading products or parts, teaches it is known to sort products based on grade (Abstract, Col. 3, lines 56-63; teaches that products or parts are graded and sorted and this is done to reduce waste, by grading to determine whether a product maybe downgraded, reworked, or sold as a lower quality product, this concept is similar to the one shown in Hormozi which shows a remanufacturer determining if a product can be reworked or remanufactured for the same reason shown in Bell for the purpose of saving money and reducing waste, by sorting the parts as done in Bell the process is more efficient and it is easier to determine which products can be remanufactured and which products need to be

scrapped. While Hormozi fails to explicitly disclose this process it would have been obvious that since parts need to be tracked and inspected it would have been obvious to sort the parts into parts that can be remanufactured and those which can't).

Therefore, from this teaching of Hormozi, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the part servicing system provided by the combination of Joao and Hormozi, with the use of sorting graded parts as taught by Bell, to reduce waste and to determine which parts that can be downgraded, reworked or remanufactured as taught by Bell. By sorting the parts as done in Bell the process is more efficient and it is easier to determine which products can be remanufactured and which products need to be scrapped. While Hormozi fails to explicitly disclose this process it would have been obvious that since parts need to be tracked and inspected it would have been obvious to sort the parts into parts that can be remanufactured and those which can't.

As per claim 2, the combination Joao and Hormozi teaches the above-enclosed invention; Joao further discloses wherein said description information comprises at least one of textual data, binary data, scanned documents, digital images, digital audio and video of said vehicular parts (Page 21, paragraph 286, Page 12, paragraph 177, Page13, paragraph 185).

As per claim 4, the combination Joao, Hormozi and Bell teaches the above-enclosed invention, Joao further discloses comprising at least one of the steps of mining data and generating reports for a plurality of vehicular parts and their assessment (Page

22, paragraph 289; discloses that the reports will include whatever plurality of parts will be necessary to affect the repairs).

As per claim 5, the combination Joao, Hormozi and Bell teaches the above-enclosed invention, Joao further discloses wherein said data and reports are compatible with internal data management systems of a party receiving said data and reports (Page 22, paragraph 299; discloses that any of the users of the system can access and use the information that is stored on the central server which is acting as the internal data management system, since all parties can access and add information all of that information has to be compatible).

As per claim 6, the combination Joao, Hormozi and Bell teaches the above-enclosed invention, Joao further discloses that warranty information is handled by the system and that the payment information would also be handled by the system (Page 22, paragraph 290; discloses that information will be sent to the warranty providers and that this information will effect who is responsible for paying for the repair).

Joao fails to explicitly disclose wherein said disposition of said vehicular part comprises at least one of discarding the vehicular part and a warranty settlement for said vehicular part based on said assessment.

While Joao fails to fully disclose the idea of a settlement, it would have been obvious to one of ordinary skill in the art at the time of the invention include a settlement during the process of determining who is responsible for paying for the repairs. For example if the user's engine seizes during normal operation they would call up the warranty provider to determine if the damage was covered by their warranty. At which

point the warranty provider would issue a disposition or final judgment if the user is to be awarded a settlement and the damage is covered by the user's warranty.

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include settlements being awarded to the user of the vehicle provided by Joao, for the purpose of ensuring that the user gets compensated for their damage to their vehicle, if it is covered by the warranty.

As per claim 7 the combination Joao, Hormozi and Bell teaches the above-enclosed invention; Joao further discloses wherein said description information comprises at least one of textual data, binary data, scanned documents, digital images, digital audio and video of said vehicular parts (Page 21, paragraph 286, Page 12, paragraph 177, Page13, paragraph 185).

As per claim 9, the combination Joao, Hormozi and Bell teaches the above-enclosed invention, Joao further discloses comprising at least one of the steps of mining data and generating reports for a plurality of vehicular parts and their assessment (Page 22, paragraph 289; discloses that the reports will include whatever plurality of parts will be necessary to affect the repairs).

As per claim 10, the combination Joao, Hormozi and Bell teaches the above-enclosed invention, Joao further discloses wherein said data and reports are in such a format as to be compatible with internal data management systems of a party receiving said data and reports (Page 22, paragraph 299; discloses that any of the users of the system can access and use the information that is stored on the central server which is

acting as the internal data management system, since all parties can access and add information all of that information has to be compatible).

As per claim 11, the combination Joao, Hormozi and Bell teaches the above-enclosed invention, Joao further discloses that the system is used to facilitate the process of repairing parts or performing services associated with those parts (Page 22, paragraph 290; discloses the central server takes in information that will help in the repair process for parts and services). Joao also discloses that many facilities can access the system (Page 22, paragraph 299; discloses that multiple parties can access the system in regard to repair and servicing of parts, these parties include intermediary or third party sites).

Joao fails to explicitly disclose sending said vehicular part to a third party for at least one of repair and recycling.

Hormozi, which talks about remanufacturing parts in the automotive industry, teaches sending vehicular parts to a third party and that services provided by the third party include repair and recycling (Page 26, paragraphs 2 and 6; teach that there are five services that can be performed two of which are repair and recycling, and that 90% of sales come from independent channels such as third parties. Page 26, paragraph 8; teaches that companies like Ford motor company have often relied on third party sites to repair and remanufacture items since they did not have the resources, from this it would be obvious that in the case of repair and recycling of parts third parties would be used if the facilities such as the dealer does not have the resources on site to complete

the task. Also it would have been obvious that since these third party sites are not located on site they would have to have the parts sent to them).

From this teaching of Hormozi, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the part servicing system provided by Joao, with the use of sending third parties parts for repair or recycling taught by Hormozi, to accomplish the required services for the customer. As mentioned in Hormozi many dealers or manufacturers don't have the resources to take on such a task as repairing parts or recycling them and often these parts were just replaced with brand new ones. Hormozi shows that the process of disposing of parts that could be salvaged is wasteful and also costs more money and energy then having those parts repaired or recycled. Since the system is dealing with third parties or companies that are not onsite the parts that have to be services would have to be sent to them in order for them to be repaired or recycled.

As per claim 12, the combination Joao, Hormozi and Bell teaches the above-enclosed invention, Joao further discloses providing an assessment based on vehicular parts (Page 22, paragraph 289; discloses that the different services providers can provide a diagnosis or an assessment regarding the state of disrepair of the part).

Joao fails to explicitly disclose comprising at least one of identifying and ordering missing materials required for a remanufacturing of said vehicular part based on said assessment.

Hormozi, which talks about remanufacturing parts in the automotive industry, teaches comprising at least one of identifying and ordering missing materials required

for remanufacturing of said vehicular part based on said assessment (Page 29, paragraphs 5 and 6 under Bills of Materials; teaches that each remanufactured parts have pieces associated with them that have to be identified, ordered and then replaced).

As per claim 13, the combination Joao, Hormozi and Bell teaches the above-enclosed invention; Joao fails to fully disclose comprising the automatically ordering said materials required for remanufacturing of said vehicular part.

Hormozi, which talks about remanufacturing parts in the automotive industry, teaches comprising the automated ordering of said materials required for remanufacturing of said vehicular part (Page 29, paragraphs 5 and 6 under Bills of Materials; teaches that each remanufactured parts have pieces associated with them that have to be identified, ordered and then replaced and that these pieces are ordered automatically if it is guaranteed that those parts will be replaced, as stated with a RF rating of 1.00, which states that every time the person in going to remanufacture that part, that piece is going to have to be replaced every time).

As per claim 14, the combination Joao, Hormozi and Bell teaches the above-enclosed invention, Joao further discloses that original equipment manufacturers have intermediaries or third parties handle things (Page 2, paragraph 21; discloses that intermediaries can act on behalf of the vehicle manufactures which are the OEM or original equipment manufacturers. Page 22, paragraph 299; discloses that these intermediaries can access the system at any time. Page 21, paragraph 281; discloses that the first location can be the vehicle manufacturer and/or intermediaries).

Joao fails to explicitly disclose where the representative or intermediary is authorized.

Hormozi, which talks about remanufacturing parts in the automotive industry, teaches that representatives of the original equipment manufacturer are authorized (Page 26, paragraph 8; teaches that Ford used outside companies as intermediaries for the exchanged of parts and services and those intermediaries were authorized representatives).

From this teaching of Hormozi, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the part servicing system provided by Joao, with the use of authorized intermediaries or third parties taught by Hormozi, for the purpose of ensuring the quality of work to their customers. If the third party did not have a high standard of work it would reflect poorly upon the original equipment manufacturer so by authorizing these companies shows the customer that these facilities are up to par with the original equipment manufacturer. Also as stated in the article this deal benefits the OEM because in some cases these they don't have the infrastructure or the resources to take on such a service so these third parties offer a reliable alternative.

As per claim 15, the combination Joao, Hormozi and Bell teaches the above-enclosed invention, Joao further discloses wherein assessment center comprises at least one of an independent assessing center, an original equipment manufacturer, and a warranty processing center (Page 22, paragraph 290; discloses that the assessment

can be any one of an independent assessing center or repair shop, equipment manufacturers, warranty providers as well as others).

As per claim 16, the combination Joao, Hormozi and Bell teaches the above-enclosed invention, Joao further discloses comprising the step of providing access to a party at a third location to said assessment (Page 22, paragraph 299; discloses that access is granted to multiple parties at any point and those parties include intermediaries or third parties. These parties can access the system to view the assessment and to add information).

As per claim 17, the combination Joao, Hormozi and Bell teaches the above-enclosed invention, Joao further discloses wherein said party at said third location accesses said assessment through an Internet web browser (Page 11, paragraph 168; discloses that the invention functions on the Internet and can be accessed using a web site which accessing would have to include the use of a web browser).

As per claim 18, the combination Joao, Hormozi and Bell teaches the above-enclosed invention, Joao further discloses wherein said party at said third location comprises an original equipment manufacturer (Page 22, paragraph 299; discloses that at any time another party can access the system which includes the vehicle manufacturer or the original equipment manufacturer).

As per claim 19, the combination Joao, Hormozi and Bell teaches the above-enclosed invention, Joao further discloses comprising producing data and reports for a plurality of vehicular parts and their assessment (Page 22, paragraph 289; discloses

that the reports will include whatever plurality of parts will be necessary to affect the repairs).

As per claim 20, the combination Joao, Hormozi and Bell teaches the above-enclosed invention, Joao further discloses comprising providing said data and reports in such a format as to be compatible with internal data management systems of a party receiving said data and reports (Page 22, paragraph 299; discloses that any of the users of the system can access and use the information that is stored on the central server which is acting as the internal data management system, since all parties can access and add information all of that information has to be compatible).

As per claim 38, the combination Joao, Hormozi and Bell teaches the above-enclosed invention, Joao further discloses comprising selecting an assessment center based on the description information (Page 22, paragraph 296; discloses based on the description information the user can selected an assessment center or any of the service or parts providers).

9. **Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao (US2002/0016655A1), in view of Amir M. Hormozi: "Parts Remanufacturing in the Automotive Industry" (First Quarter 1997) hereafter Hormozi.**

As per claim 41, Joao discloses a method for remotely evaluating a vehicular part (Page 1, paragraph 9; discloses that the invention pertains to vehicle maintenance, and that information is shared. Page 2, paragraph 15; discloses that there is a central point in which the different parties communicate through and that one of the parties are vehicle parts providers), comprising:

inputting, at a vehicular dealer, description information regarding the vehicular part in an electronic folder (Page 21, paragraph 281; discloses that the information is gathered about state of disrepair, further it states that this information can be obtained from a vehicular dealer);

sending the electronic folder including the description information to an assessment center (Page 22, paragraph 293; discloses that the central processing computer or central server transmits or sends the diagnostic report and/or repair, maintenance, and/or servicing report to the user's computer, Page 21, paragraph 282; discloses that a user can consist in any number of people including vehicle service providers and vehicle insurance providers which are equivalent to an assessment center, from this it is shown that a central server sends an electronic folder including description information to an assessment center);

receiving the electronic folder at the assessment center (Page 22, paragraph 293; discloses that the central processing computer or central server transmits or sends the diagnostic report and/or repair, maintenance, and/or servicing report to the user's computer, Page 21, paragraph 282; discloses that a user can consist in any number of people including vehicle service providers and vehicle insurance providers which are equivalent to an assessment center, from this it is shown that a central server sends an electronic folder including description information to an assessment center. Page 22, paragraph 297; discloses that the service provider or repair facility which is considered the assessment center can transmit back to the central server updated or modified information including the assessment of the vehicle and or part. Since the

grade is equivalent to the assessment then the Examiner asserts that a grade is shown as well, from this it is shown that the various users receive the information that was sent);

at a terminal at the assessment center modifying the electronic folder to include a grade for the vehicular part (as best understood by the Examiner a grade is equivalent to an assessment of a part based on the applicant's specification page 9, paragraph [0034] which states "...the folder is then returned to the dealer along with the assessment or grading...") (Page 22, paragraph 297; discloses that the service provider or repair facility which is considered the assessment center can transmit back to the central server updated or modified information including the assessment of the vehicle and or part. Since the grade is equivalent to the assessment then the Examiner asserts that a grade is shown as well. Page 20, paragraph 275; discloses that the user of the system can be any of the parties which include vehicle service providers any of these parties can enter information or modify the electronic folder. Page 21, paragraph 285; discloses that a user of the system can modify the document to include an assessment or information regarding the vehicles malfunction problems. Page 22, paragraph 299; discloses that at any time during the process any user can add additional information this includes vehicle service providers and this is done through their respective computer, from this it is clearly shown that the assessment center enters data regarding the vehicle and its parts at any time during the process and this entry is done from a terminal at the assessment center);

receiving the electronic folder at the vehicular dealer (Page 22, paragraph 293; discloses that the user can receive the diagnostic report. Page 21, paragraph 282; discloses that a user can consist in any number of people including vehicle service providers and vehicle insurance providers which are equivalent to an assessment center, from this it is shown that a central server sends an electronic folder including description information to an assessment center).

displaying at the vehicular dealer, said grade (Page 15, paragraph 213; discloses output devices the could be used by the system, which includes a display for displaying the information. Page 15, paragraph 214; discloses that the information stored in the system can be made available to any of the users of the system which include the vehicular dealer, from this it is obvious that the information is displayed);

outputting said grade at the vehicular dealer (Page 3, paragraph 39; discloses that the apparatus can send or output repair reports or assessments to the vehicle dealer; Page 10, paragraph 157; discloses that the vehicle dealer computer is in communication with the central processing computer or central server); and

automatically transmitting to an Original Equipment Manufacturer (OEM) a notification of the disposition (Page 5, paragraph [0060]; discloses that notifications can be sent to the Manufacturer automatically);

Joao fails to fully disclose determining whether said vehicular part may be recycled or disposed based on said assessment.

Hormozi, which talks about parts remanufacturing in the automotive industry, teaches disposing of the vehicular based on said assessment (Page 26, paragraphs 1

and 2; teach that there are different strategies in saving customers money and address the concerns of different constituencies, some of them include recycling and remanufacturing, as discussed above since the grade is equivalent to the assessment then the Examiner asserts that a grade is shown as well, and therefore the disposition is based on grade. Page 1, paragraph 4; teaches that the process of remanufactured products includes inspection to determine if the product is capable of being remanufactured parts are too badly worn are replaced. This inspection is an assessment of the part itself to determine if it needs to be replaced or is capable of being salvaged).

From this teaching of Hormozi, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the part servicing system provided by Joao, with the use of recycling taught by Hormozi, to accomplish the required services for the customer for less. As mentioned in Hormozi many dealers or manufacturers don't have the resources to take on such a task as repairing parts or recycling them and often these parts were just replaced with brand new ones. Hormozi shows that the process of disposing of parts that could be salvaged is wasteful and also costs more money and energy then having those parts repaired or recycled.

10. Claims 33, 34, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao (US2002/0016655A1).

As per claim 33, Joao discloses the above-enclosed invention, Joao further discloses that warranty information is handled by the system and that the payment information would also be handled by the system (Page 22, paragraph 290; discloses

that information will be sent to the warranty providers and that this information will effect who is responsible for paying for the repair).

Joao fails to explicitly disclose wherein the computer server is adapted to determine the disposition based on said grade, and wherein the output means outputs the disposition, the disposition comprising at least one of a discarding of the vehicle part and a warranty settlement for said vehicular.

While Joao fails to fully disclose the idea of a settlement, it would have been obvious to one of ordinary skill in the art at the time of the invention include a settlement during the process of determining who is responsible for paying for the repairs. For example if the user's engine seizes during normal operation they would call up the warranty provider to determine if the damage was covered by their warranty. At which point the warranty provider would issue a disposition or final judgment if the user is to be awarded a settlement and the damage is covered by the user's warranty. As discussed above since the grade is equivalent to the assessment then the Examiner asserts that a grade is shown as well, and therefore the disposition is based on grade. Further the grade could be as simple as pass or fail, for example the part is broken or not, and thus the settlement would be based on if the part needs to be replaced.

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include settlements being awarded to the user of the vehicle provided by Joao, for the purpose of ensuring that the user gets compensated for their damage to their vehicle, if it is covered by the warranty.

As per claim 34, Joao discloses the above-enclosed invention; Joao further discloses wherein said description information comprises at least one of textual data, binary data, scanned documents, digital images, digital audio and video of said vehicular parts (Page 21, paragraph 286, Page 12, paragraph 177, Page13, paragraph 185).

As per claim 37, Joao discloses the above-enclosed invention, Joao further discloses wherein said computer server is further adapted to communicate with a third location and said output means further sends said assessment to said third location (Page 22, paragraph 299; discloses that various parties can access the system, and these parties include intermediaries, these parties can obtain information and input information).

11. **Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao (US2002/0016655A1), in view of Hormozi, further in view of Bell (5,497,235) hereafter Bell as applied to claim 1 above, further in view of Williams et al. (US 2002/0032573 A1) hereafter Williams.**

As per claim 39, the combination of Joao, Hormozi and Bell teaches the above-enclosed invention, but fails to explicitly disclose printing a shipping label based on a destination identified in the determining of a disposition.

Williams, which talks about an apparatus, systems and methods for online, multi-parcel, multi-carrier, multi-service enterprise parcel shipping management, teaches printing a shipping label identifying a destination (Page 27, paragraphs [0447]-[0449];

teaches that a shipping label can be printed by the user of the system identifying a destination as well as package information details).

Therefore, from this teaching of Williams, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method for evaluating vehicular parts provided by the combination of Joao and Hormozi with the printing of shipping labels that provide destination information as taught by Williams for the purpose of expediting shipping to customers as well as to service providers. By printing the labels from the stored data the user is ensured that the information is up to date and correct, which limits the room for error.

12. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao (US2002/0016655A1), in view of Hormozi, further in view of Bell (5,497,235) hereafter Bell as applied to claim 1 above, further in view of Untiedt et al. (7,216,096) hereafter Untiedt.

As per claim 40, the combination of Joao, Hormozi and Bell teaches the above-enclosed invention, but fails to explicitly disclose adding an event-driven status indicator to the electronic folder for tracking the progress of a claim concerning the vehicular part.

Untiedt, which talks about an integrated inventory management system, teaches having an event-driven status indicator for tracking the progress of a vehicular part (Col. 2, lines 23-26, Col. 6, lines 3-36; teach that upon an event happening such as a dealer agreeing or disagreeing to supply a part the information regarding that customer request is updated with the current status in this case if the part was back ordered or not).

Therefore, from this teaching of Untiedt, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method for evaluating vehicular parts provided by the combination of Joao and Hormozi with the use of status indicators as taught by Untiedt for the purpose of keeping track of client requests and ensuring that the service is fulfilled. By including a status indicator the system is aware if the order has been fulfilled or not and this helps avoid possibly forgetting a service request or trying to fulfill a service request that has already been fulfilled.

13. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao (US2002/0016655A1), in view of Park et al. (US 2001/0039594 A1) hereafter Park.

As per claim 42, Joao discloses the above-enclosed invention, Joao further discloses a central processing computer or central server (Figure 1, character 10; discloses that the system contains a central processing computer or central server), but fails to explicitly disclose comprising validating means (server) for validating contents of said assessment based on a set of pre-defined rules.

Park, which talks about a method for enforcing workflow processes for website development and maintenance, teaches comprising validating means (server) for validating contents of said assessment based on a set of pre-defined rules (Figure 1; teaches that the system includes a server. Page 5, paragraph [0058]; teaches that server includes software that validates user-entered data based on a set of predetermined rules, from this it would have been obvious given that Joao includes a

website as shown page 11, paragraph [0168], to include on the server the software to validate user entered data on that website based on predetermined rules as taught by Park to ensure that the information is correct before proceeding).

Therefore, from this teaching of Park, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method for evaluating vehicular parts provided by Joao with the use of data validation based on rules as taught by Park, for the purpose of ensuring the data is complete and correct before proceeding. Since both Park and Joao show websites that include data entry it would have been obvious that the central server shown in Joao could be programmed to validate the information submitted by the users based on a set of predetermined rules as taught by Park.

Response to Arguments

14. Applicant's arguments filed May 17, 2010 have been fully considered but they are not persuasive.
15. In response to the applicant's argument regarding the 101 rejection, particularly that the claims now recite, "automatically transmitting to an Original Equipment Manufacturer (OEM) a notification of the disposition," the Examiner respectfully disagrees. This limitation while done automatically is not being performed by a machine particular or otherwise. That is to say a person can automatically perform a task. Further the step of transmitting itself if it were being performed by a particular machine is considered to be an insignificant extra solution activity step and thus does not constitute

a significant tie to a particular machine thus would not put the claim in a status to overcome the 101 rejection. Therefore the 101 rejection has been maintained.

16. In response to the applicant's argument regarding claim 28, specifically that "sending the electronic folder at a remanufacturer where the grade will be used for sorting the vehicular part" which is not present in any of the cited prior art," the Examiner respectfully disagrees. As stated above in the rejection this limitation does not impart any further structural limitations to claim. That is to say the title of the party receiving the information, is merely a title and does not change or alter the structure of the system in anyway. Further what the information is then used for is intended use of the information and again does not add any new structure. The Examiner asserts that the claimed limitations are found in the prior art and the rejections have therefore been maintained.

17. In response to the applicant's argument that the prior art fails to show, "automatically transmitting to an Original Equipment Manufacturer (OEM) a notification of the disposition," the Examiner respectfully disagrees. As shown in the above rejection the Joao reference discloses this feature Page 5, paragraph [0060]; discloses that notifications can be sent to the Manufacturer automatically. The rejections have therefore been maintained.

18. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

19. All rejections made towards the dependent claims are maintained due to the lack of a reply by the applicant in regards to distinctly and specifically point out the supposed

errors in the examiner's action in the prior Office Action (37 CFR 1.111). The Examiner asserts that the applicant only argues that the dependent claims should be allowable because the independent claims are unobvious and unpatentable over Joao and Hormozi , Bell, Untiedt, Park, and Williams where applicable.

Conclusion

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL FISHER whose telephone number is (571)270-5097. The examiner can normally be reached on Mon/Fri [8am/4:30pm].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571) 272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. R. F./
Examiner, Art Unit 3689

/Dennis Ruhl/
Primary Examiner, Art Unit 3689